

REMARKS

REVIEW

The original application set forth claims 1-65. Subject to a restriction requirement, Applicants earlier selected Group I, indicated as consisting of original claims 1-20 and 55-64, directed to a method for making packaging film. Non-elected claims numbered 21-54 and 65 are herein canceled by Applicants with a reservation to pursue such claims in a divisional application(s) if they so choose. Further, claims 55, 56, 58 and 64 are herein canceled.

As presently amended, the application sets forth claims 1-20, 57 and 59-63 of which claims 1, 14, 19 and 60 are independent claims. Presently, no claims have been indicated as allowed in view of the prior art. Claims 1-3, 7-9, 14, 17-19 and 55-57 stand collectively rejected under 35 U.S.C. § 102(b) as being anticipated by Hasse et al. (U.S. Patent No. 3,904,465). Claims 4 and 5 stand collectively rejected under 35 U.S.C. § 103(a) as being unpatentable over Hasse et al. in view of Marzolf (U.S. Patent No. 3,908,070). Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hasse et al. in view of Marzolf and further in view of Mak (U.S. Patent No. 6,799,680).

Claims 10 and 11 stand collectively rejected under 35 U.S.C. § 103(a) as being unpatentable over Hasse et al. in view of Bergevin et al. (U.S. Patent App. Publication No. 2003/0070751). Claims 12, 13, 15, 16 and 20 stand collectively rejected under 35 U.S.C. § 103(a) as being unpatentable over Hasse et al. in view of Mak. Claims 58 and 59 stand collectively rejected under 35 U.S.C. § 103(a) as being unpatentable over Hasse et al. in view of Bergevin et al. Finally, claims 60-

64 stand collectively rejected under 35 U.S.C. § 103(a) as being unpatentable over Hasse et al. in view of Cancio et al. (U.S. Patent No. 4,626,574).

35 U.S.C. § 102(b) REJECTION

Applicant's response to the 35 U.S.C. §102(b) rejection of claims 1-3, 7-9, 14, 17-19 and 55-57 is provided with guidance from the following case law in which it is acknowledged that: A claim is anticipated under 35 U.S.C. § 102(b) only if each and every element as set forth in the claim is found; either expressly claimed or inherently described, in a single prior art reference. Verdegaal Brothers v. Union Oil Company, 814 F.2d 628 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim of the invention. Richardson v. Suzuki Motor Company, 868 F.2d 1226, 1236 (Fed. Cir. 1989). With regard to "inherency," the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency or characteristic. In re Rijckaert, 9 F.3d 1531, 1534 (Fed. Cir. 1993). To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be recognized by persons of ordinary skill. Inherency, however, may be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. In re Robertson, 169 F.3d 743, 745. Also, a reference cannot anticipate a claim if there is any structural difference, even if the prior art device performs the function of the claim. In re Ruskin, 347 F.3d 843.

As presently amended, independent claims 1, 14 and 19 expressly require a bonding between the first and second extruded materials characterized as being in “intimate and comprehensive contact.” The films used in the manufacture of the bags of Hasse et al. are intentionally separated to create a quilting effect. Specifically, the specification states in column 4, lines 41-50:

The product produced in accord with the method and apparatus of the present invention as aforescribed provides an excellent protective packaging material with cushioning action especially, for example, in the packaging of delicate, easily damaged instruments or other fragile articles. The packaging material of the present invention offers excellent resistance to shock or impact for said articles due to the inherent pneumatic cushioning properties imparted by the encapsulated air present in such packaging materials.

Emphasis added. It is respectfully submitted that as amended, the present claims lack the quilted aspects of the prior art of Hasse et al. and, in fact, specifically claim away from such teaching through the requirement of comprehensive contact across the full breadth and width of the extruded materials to form the multi-layer film. This is more easily understood by a simple comparison of Fig. 9 of the proposed reference, Hasse et al., and Fig. 16 of the present application showing cross-sections of the multi-layer films as disclosed and claimed in the respective patent and application.

Lacking each and every element of the invention as claimed, it is respectfully submitted that the present anticipatory ground of rejection is improper and withdrawal of same is requested. It is further submitted that independent claims 1, 14 and 19 are now believed in condition for allowance. Claims 2-13, 15-18, 20, 57 and 59, which depend from and further define claims 1, 14 and 19, are also believed in condition for allowance. Acknowledgement of same by issuance of a formal Notice of Allowance is earnestly solicited.

35 U.S.C. § 103(a) REJECTIONS*Rejection of Claims 4 and 5*

For the reasons stated above, it is respectfully submitted that the proposed basis of the combination of references used to reject dependent claims 4 and 5 of the present application cannot serve as a proper basis for an obviousness rejection. Specifically, the proposed base reference teaches away from the present invention in that it teaches stretching one of the extruded materials such that it generates a recess over which the second extruded material is draped and bonded, thus forming a film with encapsulated pockets of air therein. The encapsulated air pockets form the “pattern” on the multi-layer film.

The claims of the present application, as amended, specifically require the bonding of the plurality of extruded materials in “intimate and comprehensive contact” across the width and breadth of the materials. There can be no air pockets formed between the extruded materials (i.e., within the film). As the proposed secondary reference fails to solve this shortcoming of the proposed base reference, it is respectfully submitted that the proposed combination of references does not disclose the presently claimed method. Withdrawal of the present obviousness ground of rejection for claims 4 and 5 are requested and issuance of a formal Notice of Allowance is earnestly solicited.

Rejection of Claim 6

As discussed in more detail with regard to the obviousness rejection of claims 4 and 5, it is respectfully submitted that the presently proposed base reference, Hasse et al., cannot properly serve as a basis for an obviousness rejection as it teaches away from the present invention. Further, it is respectfully submitted that the proposed secondary references, Marzolf and Mak, fails to resolve the above-discussed shortcomings of Hasse et al. Withdrawal of the present ground of rejection of claim 6 and issuance of a formal Notice of Allowance is earnestly solicited.

Rejection of Claims 10 and 11

As discussed in more detail with regard to the obviousness rejection of claims 4 and 5, it is respectfully submitted that the presently proposed base reference, Hasse et al., cannot properly serve as a basis for an obviousness rejection as it teaches away from the present invention. Further, it is respectfully submitted that the proposed secondary reference, Bergevin et al., fails to resolve the above-discussed shortcomings of Hasse et al. Withdrawal of the present ground of rejection of claims 10 and 11 and issuance of a formal Notice of Allowance is earnestly solicited.

Rejection of Claims 12, 13, 15, 16 and 20

As discussed in more detail with regard to the obviousness rejection of claims 4 and 5, it is respectfully submitted that the presently proposed base reference, Hasse et al., cannot properly serve as a basis for an obviousness rejection as it teaches away from the present invention. Further, it is respectfully submitted that the proposed secondary reference, Mak, fails to resolve the above-

discussed shortcomings of Hasse et al. Withdrawal of the present ground of rejection of claims 12, 13, 15 and 16 and issuance of a formal Notice of Allowance is earnestly solicited.

Rejection of Claims 58 and 59

It is respectfully submitted that in light of the cancellation of claim 58, such rejection is moot. As discussed in more detail with regard to the obviousness rejection of claims 4 and 5, it is respectfully submitted that the presently proposed base reference, Hasse et al., cannot properly serve as a basis for an obviousness rejection of claim 59 as it teaches away from the present invention. Further, it is respectfully submitted that the proposed secondary reference, Bergevin et al., fails to resolve the above-discussed shortcomings of Hasse et al. Withdrawal of the present ground of rejection of claim 59 and issuance of a formal Notice of Allowance is earnestly solicited.

Rejection of Claims 60-64

It is respectfully submitted that in light of the cancellation of claim 64, such rejection is moot. As discussed in more detail with regard to the obviousness rejection of claims 4 and 5, it is respectfully submitted that the presently proposed base reference, Hasse et al., cannot properly serve as a basis for an obviousness rejection of independent claim 60 and its dependent claims 61-63 as it teaches away from the present invention. Further, it is respectfully submitted that the proposed secondary reference, Cancio et al., fails to resolve the above-discussed shortcomings of Hasse et al. It is respectfully submitted that independent claim 60 is now in condition for allowance. Claims 61-63 which depend from and further limit claim 60 are also submitted as being in condition for

allowance. Withdrawal of the present ground of rejection of claims 60-63 and issuance of a formal Notice of Allowance is earnestly solicited.

CITED RELEVANT PRIOR ART

It is not believed that any of the prior art cited either by the Examiner or the Applicant, alone or in combination either with each other or other cited prior art teaches, discloses, suggests or makes obvious the claimed features of the present invention.

CONCLUSION

In view of the foregoing, Applicants respectfully request withdrawal of the current grounds of rejection and the issuance of a formal Notice of Allowance. The Examiner is invited to telephone the undersigned at his/her convenience should only minor issues remain after consideration of this amendment in order to permit early resolution of the same.

Respectfully submitted,

11/8/07
Date

Charles R. Ducker, Jr.
Charles R. Ducker, Jr.
Reg. No. 46,542